THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GERHARD LOFFLER

Appeal No. 97-2885
Application 08/384,847[1]

ON BRIEF

Before CALVERT, ABRAMS and McQUADE, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Gerhard Loffler appeals from the final rejection of claims 1 and 2, the only claims pending in the application. We reverse and enter a new rejection of claim 2 pursuant to 37

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[1] Application for patent filed February 7, 1995.

CFR § 1.196(b).

The invention relates to "a multicolor printing method wherein a printed image on a printed material is attained with at least two passes" (specification, page 1). A copy of appealed claims 1 and 2 appears in the appendix to the appellant's brief (Paper No. 15).

The references relied upon by the examiner as evidence of obviousness are:

Minschart	4,994,975	Feb. 19, 1991
Steiner et al. (Steiner)	5,181,257	Jan. 19, 1993
Sainio et al. (Sainio)	5,412,577 (filed Oct. 28, 1992)	May 2, 1995

Claims 1 and 2 stand rejected:

a) under 35 U.S.C. § 112, first paragraph, as being based on a specification which fails to provide an enabling disclosure; and

b) under 35 U.S.C. § 103 as being unpatentable over Sainio or Steiner in view of Minschart.

Reference is made to the appellant's brief (Paper No. 15)

and to the examiner's answer (Paper No. 16) for the respective positions of the appellant and the examiner with regard to the merits of these rejections.[2]

The first rejection rests on the examiner's determination that the appellant's specification fails to comply with the enablement provision of 35 U.S.C. § 112, first paragraph. The dispositive issue with regard to this provision is whether the appellant's disclosure, considering the level of ordinary skill in the art as of the date of the appellant's application, would have enabled a person of such skill to make and use the appellant's invention without undue experimentation. In re Strahilevitz, 668 F.2d 1229, 1232, 212 USPQ 561, 563-64 (CCPA 1982). In calling into question the enablement of the appellant's disclosure, the examiner has the

[2] The examiner has refused entry of the reply brief filed by the appellant on February 24, 1998 (Paper No. 18). Accordingly, we have not considered the arguments advanced in the reply brief in reviewing the merits of the instant appeal.

initial burden of advancing acceptable reasoning inconsistent with enablement. Id. In essence, the examiner contends that "[t]he disclosure is inadequate in disclosing what specific computer hardware, circuit components and computer software is encompassed by the recited system components as disclosed and claimed so as to enable the

desired press functions relating to registration to be performed" (answer, page 3). A review of the record, however, indicates that the appellant has made a fairly detailed disclosure of the hardware components and associated operational relationships involved in the claimed method (see, for example, specification pages 5 through 13 and drawing Figures 1 through 3). Given the relatively specific and straightforward nature of this disclosure, it is not evident, nor has the examiner cogently explained, why the appellant's specification would not have enabled a person of ordinary skill in the art to make and use the claimed invention without undue experimentation.

Accordingly, we shall not sustain the standing 35 U.S.C. § 112, first paragraph, rejection of claims 1 and 2.

Nor shall we sustain the standing 35 U.S.C. § 103 rejection of claim 2 as being unpatentable over Sainio or Steiner in view of Minschart.

For the reasons expressed below, claim 2 is indefinite. Thus, the standing prior art rejection thereof must fall since it is necessarily based on speculative assumption as to the meaning of the claim. See In re Steele, 305 F.2d 859, 862-63, 134 USPQ 292, 295 (CCPA 1962). It should be understood, however, that our

decision in this regard rests solely on the indefiniteness of the claimed subject matter, and does not reflect on the adequacy of the prior art evidence applied to support the rejection.

As for the standing 35 U.S.C. § 103 rejection of claim 1, the appellant's basic argument that the applied references would not have suggested a method meeting the claim limitations requiring a multicolor printing of a printed image on printed material in at least two passes through a printing machine wherein image signals picked up by an image pickup device in a first pass of the printed material through the

machine are stored and applied to a steering or control process in subsequent passes of the printed material through the machine is well taken. In this regard, neither Sainio nor Steiner teaches passing printed material through a printing machine in multiple passes, much less using image signals picked up in the first pass in a steering or control process in subsequent passes of the printed material through the machine. Minschart's disclosure of a web registration method fails to cure these deficiencies.

Consequently, we shall not sustain the standing 35 U.S.C. § 103 rejection of claim 1 as being unpatentable over Sainio or Steiner in view of Minschart.

The following rejection is entered pursuant to 37 U.S.C. § 196(b).

Claim 2 is rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter the appellant regards as the invention.

The scope of claim 2 is indefinite for the following reasons. To begin with, the "obtaining" step recited in the

claim is unclear in that it does not indicate how or when the image signals are generated. This problem is compounded in the "applying" step wherein the reference to the "at least one subsequent pass of the printed material through the printing machine" lacks a proper antecedent basis due to the failure of the claim to recite any preceding pass of the printed material through the machine. Finally, the reference in the "applying" step to "the stored ink coverage values" lacks a proper antecedent basis since the "storing" step in the claim is directed to the image signals rather than to the ink coverage values obtained from the image signals.

In summary:

a) the decision of the examiner to reject claims 1 and 2 under 35 U.S.C. § 112, first paragraph, and under 35 U.S.C. § 103 is reversed; and

b) a new 35 U.S.C. § 112, second paragraph, rejection of claim 2 is entered pursuant to 37 CFR § 1.196(b).

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

> (1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .
>
> (2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED; 37 CFR § 1.196(b)

IAN A. CALVERT Administrative Patent Judge	)	
NEAL E. ABRAMS Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JOHN P. McQUADE Administrative Patent Judge	)	

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